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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/659,021      | 09/11/2003  | Roger Mervyn LLoyd Foote | PAK30US             | 4224             |

24011 7590 03/12/2004

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BALMAIN, 2041  
AUSTRALIA

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| EXAMINER |
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NGUYEN, JUDY

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2861

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                              |  |
|------------------------------|-------------------------------|------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/659,021 | Applicant(s)<br>FOOTE ET AL. |  |
|                              | Examiner<br>Judy Nguyen       | Art Unit<br>2861             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 and 9-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/11/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1, 7, 8, 10, 12 and 14 objected to because of the following informalities:

- Claim 1, lines 6, 8, 9, 13: “, or each” should be deleted. There is only one.
- Claim 1, lines 10-11, 17: “, or each,” should be deleted.
- Claim 7, line 1: “or each” should be deleted.
- Claim 7, line 4: “, or each” should be deleted.
- Claim 8, line 2: “, or each” should be deleted.
- Claim 10, line 1: “, or each,” should be deleted.
- Claim 10, lines 5, 5-6: “, or each” should be deleted.
- Claim 12, lines 1, 3: “, or each” should be deleted.
- Claim 14, line 2: --third—should be inserted before “recess” because there is more than one recess.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 2861

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 7, 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,655,786.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims the features recited in the claims of the present application as follows:

- An elongate receiving member that defines a receptacle [column 8, lines 15-17].
- At least one elongate printhead module [column 8, line 18], the printhead module defining a channel in which a printhead chip is receivable [column 8, lines 28-29].
- The receiving member and the printhead module together defining pairs of complementary location formations such that the printhead module is received in the receptacle so that the complementary locating formations engage each other [column 8, lines 32-34], with the module extending along a longitudinal axis of the receiving member [column 8, lines 22-23].
- The complementary location formations comprise a first pair of complementary location formations [column 8, lines 32-35].

- The first pair comprising a projection [corresponding to claimed engaging member which must be in a form of projection to allow it to be engaged with the claimed corresponding recess] and a recess [column 8, line 43] adapted to receive the projection.
- The recess is extended in the longitudinal direction with respect to the projection, the projection is slidably received within the recess so that expansion of the printhead module relative to the receiving member along the longitudinal axis is accommodated [column 8, lines 42-50].
- The receiving member has opposed walls interconnected by a bridging portion to define the receptacle [column 8, lines 15-17].
- A plurality of printhead modules arranged in end-to-end relationship in the receptacle [column 8, lines 18-19], each channel being angled with respect to its associated module so that the printhead chips of adjacent modules overlap [column 8, lines 27-31].
- Each printhead module has a set of locating formations and in which the receiving member has a complementary set of locating formations at a location for each module in the receptacle [column 8, lines 32-35].
- The complementary location formations further comprises a second pair of complementary location formations comprising a projection and a correspondingly sized recess for receiving the projection to locate the printhead module in a longitudinal direction within the receiving member [column 8, lines 42-50].

Art Unit: 2861

- The recesses of the first and second pair of complementary location formations are formed in a first wall of the printhead module, and the projections of the first and second pair of complementary location formations are formed in a first wall of the receiving member [column 8, lines 42-50].

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,655,786 in view of Cowger et al (US 5,565,900).

The patent claims all claimed features of the present application except for each module being stepped at its end to nest with a consecutive module.

However, Cowger et al teaches a plurality of modules each being stepped at its end to nest with a consecutive module [see Figures 1, 2].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make each claimed module in the patent to be stepped at its end to nest with a consecutive module as taught by Cowger et al for the purpose of preventing gaps between the nozzles of the modules.

***Allowable Subject Matter***

Art Unit: 2861

Claims 6, 9, 11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10, 12, and 14 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (571) 272-2258. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2861

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Judy Nguyen".

Judy Nguyen  
Primary Examiner  
March 8, 2004